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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,558	02/05/2004	Carmella Jannuzzi	1338.1001	5530

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EXAMINER

GILBERT, SAMUEL G

ART UNIT PAPER NUMBER

3736

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,558	<b>Applicant(s)</b> JANNUZZI, CARMELLA	
	<b>Examiner</b> Samuel G. Gilbert	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6-9, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bakunin et al(3,504,665). Element -28 is an exciter that is inserted into the vagina and element -32- is a clitoral stimulator. The mechanical means are set forth in the handle shown in Figures 1 and 4.

Claim 14 – is rejected because if the claim was rewritten as an independent claim the claim would include “mechanical means for movement or a combination of movements”. Bakunin teaches movement therefore the claim is anticipated.

Claim 6 – Bakunin teaches vibrating which by definition imparts an oscillating motion. The examiner is taking oscillating motion as a back and forth movement. Webster's, Ninth New Collegiate Dictionary , 1983, page 1313.

Claims 1, 2, and 5 rejected under 35 U.S.C. 102(b) as being anticipated by Rebell(4,917,104). Rebel teaches a “J” shaped device having a curved portion, shown in figure 1, with the curved portion being on the right side and the straight portion being

on the left. Further, elements -40- and -32- provide means for arcuate and extending movement.

Claims 1, 2, 4-8 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bates et al. (2,957,474).

Bates et al teaches a "j" shape as shown in figure 7. The device imparts extending motion, figure 1, the examiner is taking the extending motion to be arcuate. The device also vibrates, causing back and forth motion as described above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bakunin et al (3,504,665) as applied to claim 1 above, and further in view of Tsai (6,190,307). Bakunin et al teaches a stimulation device as claimed which imparts oscillating motion to the stimulation device. A circular motion is not taught. Tsai teaches a stimulation device having both internal and external stimulation components which can be driven in a circular motion, applicant's attention is invited to figure 5 and

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the related written description. In the absence of showing any criticality in the type of motion selected for stimulation it would have been obvious to one of ordinary skill in the art at the time the invention was made to select any known type of motion as an ordinary design expedient. In this case it would have been obvious to one of ordinary skill to use the circular rotation taught by Tsai in place of the oscillating motion taught by Bakunin et al.

Bakunin et al. teaches a vibrating appendage for clitoral stimulation but the stimulator is not cup shaped or textured. Tsai teaches a cup shaped clitoral stimulation –20- and texture to increase stimulation –11-. In the absence of showing any criticality in the shape of the clitoral stimulator it would have been obvious to one of ordinary skill in the art at the time the invention was made to select any known shape for the stimulator as an ordinary design expedient. It is also well known in the stimulation arts that textured surfaces impart a greater tactile stimulation than a smooth surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide texture to the clitoral stimulator to maximize the tactile stimulation provided by the clitoral stimulator as taught by Tsai.

### ***Response to Arguments***

Applicant's arguments filed 12/13/2004 have been fully considered but they are not persuasive. The applicant argues Bakunin does not teach a combination of movements to the curved portion. The examiner is taking the position that claim 1 is not

limited to a combination of movements because claim 1 calls for "mechanical means for movement *or* a combination of movements".

Regarding the rejection Bakunin et al. in view of Tsai, the applicant again argues "combination of movement" which has been addressed above. Further, the applicant argues there is no motivation to combine the two references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case first that the applicant has not shown any criticality in the exact movement to be applied and second by using the motion/means taught by Tsai in place of the motion/means of Bakunin one would gain the advantage of having motion in two dimensions in that the device would have a circular motion and an extending motion at the same time such a motion is not taught by Bakunin alone.

#### ***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach a plurality of buttons connected to means performing the recited functions.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenberg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel G. Gilbert  
Primary Examiner  
Art Unit 3736

sgg